

REMARKS

Applicants hereby add new claims 12-15. Accordingly, claims 1-15 are pending in the present application.

Claims 1-3 and 7-11 stand rejected under 35 USC 102(b) for anticipation over U.S. Patent No. 5,161,300 to Nanjyo. Claim 4 stands rejected under 35 USC 103(a) for obviousness over Nanjyo. Claim 5 stands rejected under 35 USC 103(a) for obviousness over Nanjyo in view of Applicant(s) Admitted Prior Art (AAPA). Claim 6 stands rejected under 35 USC 103(a) for obviousness over Nanjyo in view of Japanese Patent No. JP 1-220207 ("JP '207").

Applicants respectfully traverse the rejections and urge allowance of the present application.

Applicants have amended the specification and title as requested by the Office. Applicants respectfully request approval of the specification and the title.

Referring to the 102 rejection of claim 1, the Office Action on pages 2-3 alleges that references 13, 14 of Nanjyo disclose the claimed head components, core block 2 discloses the claimed support region, and glass 15 discloses the claimed component regions. The method of claim 1 recites providing the *component regions between respective ones of the head components and a path of travel of the media*. Applicants note as recited at col. 4, lines 1-2 of Nanjyo, surfaces 1b, 2b are recording-medium slide surfaces. In no fair interpretation may glass 15 of Figs. 3A or 3B of Nanjyo be considered to be between the path of travel of the media and the references 13, 14 identified by the Office as disclosing the claimed head components. Accordingly, positively-recited limitations of claim 1 are not disclosed nor suggested by the prior art and claim 1 is allowable for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants amended claim 6 as indicated herein and as supported by exemplary embodiments at page 8, lines 10-29 of the originally filed application.

New claims 12-13 depend from claim 1. Support for the amendment to claim 1 and the new claims is provided at least by Figs. 7-8 and the associated specification teachings of the originally-filed application.

New independent claims 23-24 correspond to originally filed independent claim 1 plus limitations of respective dependent claims 4 and 6. With respect to claim 24, Applicants changed component regions (as recited in claim 6) to support regions as supported by page 8, lines 10-29 of the originally filed application. Applicants respectfully assert that the new independent claims are allowable for at least the following compelling reasons.

More specifically, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2).

As demonstrated below, the Office has failed to establish proper *prima facie* 103 rejections of dependent claims 4 and 6 and claims 23-24 are allowable.

New claim 23 recites the forming the head components to *individually comprise a read element and a write element* as previously defined in claim 4. The Office on page 4 of the Action took Official Notice in support of the rejection of claim 4. Applicants hereby traverse and seasonably challenge any reliance upon Official Notice pursuant to MPEP §2144.03 (8th ed., rev. 2), and requests the Examiner cite a reference or affidavit in support of his or her position in a *non-final Action* if claim 23 is not allowed.

MPEP 2144.03A (8th ed., rev. 2) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known*. It is *not appropriate* for the Office to take office notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. Pursuant to MPEP §2144.03 (8th ed., rev. 2), Applicants hereby demand evidence with respect to what the Examiner apparently relies upon as being "well-known."

In particular, Applicants state that there is no evidence of record that individual ones of the head components comprise both a read element and a write element as specifically claimed. Applicants have failed to identify any teachings in Nanjyo that the references 13, 14 (i.e., relied upon as allegedly disclosing the head components) individually include both a read element and a write element as claimed. In fact, Applicants have electronically searched Nanjyo and has failed to uncover any teachings to reading or writing. Positively recited limitations of claim 23 are not disclosed nor suggested by the prior art, the Office has failed to establish a proper prima facie 103 rejection and claim 23 is allowable for at least this reason. Applicants respectfully submit that new claim 23 is allowable for at least this compelling reason.

Referring to independent claim 24, the method recites providing an insulating layer and the providing the support regions comprises removing portions of the insulating layer to form the support regions. The Office identifies reference 2 as disclosing the support region on page 3 of the Action. On page 5 of the Action, the Office erroneously equates the glass layer as allegedly discloses the claimed insulating layer. Applicants disagree with the interpretation of the teachings of Nanjyo. More specifically, the Office on page 4 of the Action states that glass layer 15 allegedly discloses the claimed component regions. Claim 24 recites the step of providing the insulating layer *in addition to the providing the component regions*. More specifically, claim 24 recites the insulating layer as a different limitation than the component regions. However, the Office improperly relies upon the single material glass 15 as allegedly disclosing both the claimed component regions and the insulating layer contrary to the method of claim 24. Accordingly, even if the limitations of the references are combined, positively recited limitations of claim 24

are not disclosed nor suggested by the prior art and claim 24 is allowable for at least this reason.

Further, the Office relies up JP '207 as allegedly disclosing removing portions of an insulating layer. However, even if the references are combined, the combination of reference teachings fails to disclose or suggest the providing the support regions comprises removing portions of the insulating layer to form the support regions as claimed. Mere grinding of glass to remove excess insulating layer material fails to disclose or suggest removal to form support regions as claimed. Accordingly, even if the prior art references are combined, the combination fails to disclose or suggest limitations of claim 24 and claim 24 is allowable for this additional reason.

In addition, there is no motivation to combine the teachings of JP '207 with the teachings of Nanjo and the 103 rejection is improper for this additional reason. The Office states on page 5 of the Action that the motivation for the combination is to remove any excess insulating layer and improve the dimensional accuracy. However, there is no evidence of record that Nanjo suffers from dimensional inaccuracies to motivate one to look to JP '207 for meaningful teachings. Col. 4, lines 25-35 of Nanjo states that the blocks 13, 14 are formed in conformity with the shape of grooves 11, 12 to completely close the grooves and the planes 13a, 14a of blocks 13, 14 become flush with the surfaces 7, 8. There is no concern or problems experienced in Nanjo with respect to "excess insulating layer" or "dimensional inaccuracies" to motivate one to look to JP '207 for meaningful teachings. Further, JP '207 is concerned with problems wherein gaps are filled with glass. Nanjo discloses the usage of glass 15 in notches of blocks 13, 14 as opposed to comprising the blocks themselves. Accordingly, there is no evidence of record that the disclosure of Nanjo experiences any problems associated with the disparate teachings of JP '207 to motivate one to look to JP '207 for meaningful teachings or that any improvement to Nanjo would result even if the teachings were combined. The only motivational rationale of record is based upon the subjective opinions of the Office concerning problems of JP '207 which have not been demonstrated by evidence to be of concern to Nanjo. Applicants respectfully submit the solution proposed by JP '207 has not been demonstrated to be relevant or offer any benefit to the design of Nanjo using blocks 13, 14 having glass 15 in

respective notches. As discussed further below, the opinions of the Office without objective support are insufficient for a proper 103 rejection.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale on which it relied. There is no evidence that Nanjo is concerned with problems regarding dimensional inaccuracies or that the teachings of JP '207 directed towards disparate designs compared with the design of Nanjo would provide any improvement to the designs of Nanjo. There is absolutely no evidence of record to support the subjective conclusory statement of the Examiner that the resulting combination of reference teachings would have any improvement compared with the teachings of Nanjo taken independently. The only motivation presented in the Office Action is based upon the Examiner's subjective belief or unknown authority which is insufficient as clearly held by the applicable authority.

As set forth by the Federal Circuit, there is no motivation and the Office Action has failed to establish a prima facie case of obviousness and accordingly the 103 rejection is improper. Applicants respectfully submit the Office has failed to establish a proper 103 rejection of previously pending claim 6 for at least the above numerous compelling reasons and claim 24 is allowable.

Applicants submit an Information Disclosure Statement herewith to disclose prior art of record in the parent application.

Allowance of all claims is respectfully requested.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Richard H. Henze
Albert H. Jeans
Paul W. Poorman

By:


James D. Shurette
Reg. No. 39,833

Date: 6/20/05